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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION·NO.
10/632,887	08/01/2003	Joanne L. Clowes	MS1-1367US	3041

22801	7590	10/03/2006	

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EXAMINER
RUSSELL, TRACI L

ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/632,887	CLOWES, JOANNE L.
	Examiner	Art Unit	
	Traci L. Russell	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*08/01/2003*</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08/01/2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-SB/08)
    Paper No(s)/Mail Date <u>*10/04/2004*</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Pursuant to U.S.C. 131, claims 1-26 have been examined.

Claim Objections

1.   Claim 25 is objected to because of the following informality: The claim limitation

disclose a computer readable memory having computer readable instructions that when

executed by a processor. Appropriate correction is required to read 'computer readable

medium'.

2.   Claim 18 is objected to because of the following informality: The claim limitation

disclose the method of game 16. Appropriate correction is required to read 'the method

of claim 16'.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter, which the applicant regards as his invention.

4.   Claims 16, 25, and 26 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Each claim limitation discloses 'attempting to'

which is vague and indefinite language. Appropriate correction is required.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 1 - 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3.   Claims 1 - 5, and 6 - 12 disclose a apparatus comprising media including game content and a data protection, media type checking portion, and alteration checking portion.

It appears that the claims are directed towards a functional descriptive, per se, which does not produce a useful, concrete and tangible result. The indicating step is conditional and the result has not been utilized nor made available in such a manner that any usefulness of having performed the validation can be realized. Appropriate amendment to the claim is required to continue the process until there is a tangible result.

4.   Claims 13 - 15 disclose an apparatus comprising game content, non-game content, and media content in which the claims disclose functional-descriptive material per se. Claim 15 discloses content stored in a non-game console specific format but fails to limit the claim to include a mode of storage that would enable the claims statutory. Appropriate amendment to the claims is required.

5.   Claims 16 - 24 disclose a method, which fails to produce a useful, tangible, and

concrete result. Appropriate amendment to the claims is required.

6.   Claim 25 disclose a computer readable memory having instructions, which fail to

produce a useful, concrete, and tangible result. Appropriate amendment to the claim is

required.

Double Patenting

1.   The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees.   A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163

USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.   Claims 1 - 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, and 6-30 of copending Application No. 10/632,250. Although some of the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention is an obvious variation of the claimed invention in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that

copending application since the referenced copending application and the instant

application are claiming common subject matter, as shown in the table below:

Instant Application: 10/632,887 Claim 1	Co-pending Application: 10/632,250 Claim 1
An apparatus comprising:	An apparatus comprising:
1(a) a media including game content; and	1(a) a media including game content; and
1(b) a data protection portion including a file system alteration checking portion that protects the apparatus from modification of the game content by determining whether the game content has been modified, and if the game content has been modified, then the use of the game content within the apparatus fails.	1(b) a data protection portion that includes a file alteration checking portion, the file alteration portion protects the media from modification of the game content by determining whether the game content has been modified, and if the game content has been modified, then the installation of the game content within the apparatus fails.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1 – 26 are rejected under 35 U.S.C. 102(e) as being unpatentable by

Whitten, et al (US 2003/0182574).

with regard to claim 1:

Whitten, et al discloses a system and method for securing digital data to be distributed for use on a computing device comprising: a media including game content; and a data protection portion including a file system alteration checking portion that protects the apparatus from modification of the game content by determining whether the game content has been modified, and if the game content has been modified, then the use of the game content within the apparatus fails ['computing device'; Page 2, paragraphs 9, 11].

with regard to claim 2:

Whitten, et al discloses and method as required in the apparatus of claim 1, wherein the media includes a removable media that is removable from the apparatus [Fig 1; 'game console'; Page 3, paragraph 27].

with regard to claim 3:

Whitten, et al discloses a method as required in the apparatus of claim 2, wherein the removable media includes an optical disk ['optical storage disk, 108' in Fig 1; Page 1, paragraph 7].

in regard to claim 4:

Whitten, et al discloses a method as required by the apparatus of claim 2, wherein the removable media includes a digital video disk ['digital versatile disc'; Page 1, paragraph 7; 'DVD disc'; Page 3, paragraph 27].

in regard to claim 5:

Whitten, et al disclose the apparatus as required of claim 1, wherein the

apparatus includes a game console ['game console, 102' in Fig 1; Page 3, paragraph

27].

in regard to claim 6:

Whitten, et al disclose the apparatus as required of claim 1, wherein the data

protection portion includes a media type checking portion for checking whether the type

of the media is as expected for media that has not been copied [Page 5, paragraph 51].

in regard to claim 7:

the apparatus of claim 6, wherein the media type checking portion reduces the

possibility of copying the game content from a pressed disk to an end user writable disk

['decision step 442' of Fig 6; Page 6, paragraph 58].

in regard to claim 8:

Whitten, et al disclose the apparatus as required of claim 1, wherein the data

protection portion checks the entire file to ensure that the media has not been

invalidated ['decision steps 440, 444, 445'; Page 6, paragraphs 57-59].

in regard to claim 9:

Whitten, et al disclose the apparatus as required of claim 1, wherein the data protection portion includes a file signature checking portion for checking whether the file signature is as expected for media that has not been modified ['decision step 446'; Page 6, paragraph 60; 'decision step 462'; Page 7, paragraph 64].

in regard to claim 10:

Whitten, et al disclose the apparatus as required of claim 9, wherein a signature check is performed on files as they are accessed [Fig 7; Page 6, paragraph 62].

in regard to claim 11:

Whitten, et al disclose the apparatus as required of claim 1, wherein the data protection portion checks the contents of a file as it is opened [Page 6, paragraph 63].

in regard to claim 12:

Whitten, et al disclose the apparatus as required of claim 1, wherein the file system alteration checking portion allows sector level validation rather than file level validation [Page 6, paragraph 62].

in regard to claim 13:

Whitten, et al disclose the apparatus as required of claim 1, wherein the game content is stored in a game console specific format [Page 3, paragraph 25, 27].

in regard to claim 14:

Whitten, et al disclose the apparatus as required of claim 1, wherein the media content includes non-game content [Page 3, paragraphs 32-35].

in regard to claim 15:

Whitten, et al disclose the apparatus as required of claim 14, wherein the non-game content is stored in a non-game console specific format [Page 3, paragraphs 32-35].

in regard to claim 16:

Whitten, et al discloses a method comprising: attempting to mount a file system, wherein the attempting to mount the file system includes comparing an actual signature of a table of contents from a media with an expected signature of the table of contents; and attempting to read a cluster of sectors from the media, wherein the attempting to read the cluster of sectors includes, for every cluster of sector read, calculating an actual signature, and comparing the actual signature with an expected signature found in the table of contents for every cluster of sectors read ['step 420'; Page 5, paragraph 54; 'decision steps 434, 436, 438, 440, 445, 442, 430, 444, 446, 448, 450, 452, 456, 458; Page 6, paragraphs 56-63].

in regard to claim 17:

Whitten, et al disclose the method as required of claim 16, wherein the file exists

on removable media [Page 3, paragraph 27].

in regard to claim 18:

Whitten, et al disclose the method as required of game 16, wherein the method is

run on a game console [Page 1, paragraph 3; Page 3, paragraph 27].

in regard to claim 19:

Whitten, et al disclose the method as required of claim 16, wherein the data is

stored in a non-game console specific format [Page 3, paragraphs 32-35].

in regard to claim 20:

Whitten, et al disclose the method as required of claim 16, wherein method is a

file system alteration check [Page 6, paragraphs 56, 57].

in regard to claim 21:

Whitten, et al disclose the method as required of claim 16, that interfaces with a

media containing game content [Page 6, paragraph 58].

in regard to claim 22:

Whitten, et al disclose the method as required of claim 16, that interfaces with a

media containing non-game content [Page 6, paragraph 59].

in regard to claim 23:

Whitten, et al disclose the method as required of claim 16, wherein the data is stored in a game console specific format [Page 6, paragraphs 56-59].

in regard to claim 24:

Whitten, et al discloses a method comprising: obtaining game content from a media; and protecting the game content from modification by determining whether the game content has been modified, and if the game content has been modified, then failing to allow the use of the game content, wherein the protecting the game content includes a file system alteration checking portion [Page 2, paragraph 12].

in regard to claim 25:

Whitten, et al discloses computer readable memory having computer readable instructions that when executed by a processor causes the processor to: attempt to use a file, wherein the attempting to use the file includes comparing an actual signature of a table of contents from a media with an expected signature of the table of contents; and attempt to read a cluster of sectors from the media, wherein the attempting to read the cluster of sectors includes, for every cluster of sectors read, calculating an actual signature, and comparing the actual signature with an expected signature found in the table of contents for every cluster of sectors read [Page 2, paragraph 15].

in regard to claim 26:

Whitten, et al discloses a method comprising: attempting to mount a file system, wherein the attempting to mount the file system includes: acquiring an expected signature for a table of contents from a media, comparing an actual signature of the table of contents with the expected signature of the table of contents, if the expected signature of the table of contents does not match the actual signature of the table of contents, then failing to mount the file system, and if the expected signature of the table of contents does match the actual signature of the table of contents, then mounting the file system; and attempting to read a cluster of sector from the media, wherein the attempting to read the cluster of sector includes: for every cluster of sector read, calculating an actual signature, comparing the actual signature with an expected signature found in the table of contents for every cluster of sector read, if the actual signature for the cluster of sector does not match the expected signature for the cluster of sector, then failing to read the clusters of data from the media, and if the actual signature for the cluster of sector does match the expected signature for the cluster of sector, then reading the clusters of data from the media [Page 2, paragraphs 9-14].

In the broadest sense, a computing device may be any device that includes a processor that executes machine instructions stored in a memory to perform some function. Thus, a computing device can have a dedicated function, or may be very general in functionality, as disclosed by Whitten, et al [Page 1, paragraph 2].

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Traci L. Russell whose telephone number is

571.270.1095. The examiner can normally be reached on Mon - Fri (alternate Fridays

off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nassir Moazzami can be reached on 570.272.4195. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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